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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/286,822	04/05/1999	THOMAS A. GRATE	MS1-305US	5476

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EXAMINER

BLAIR, DOUGLAS B

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 04/08/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/286,822

Applicant(s)

GRATE ET AL.

Examiner

Douglas B Blair

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Amendment***

1. The declaration filed on 3/26/2003 under 37 CFR 1.131 has been considered but is ineffective to overcome the O'Neill reference.
2. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the O'Neill reference to either a constructive reduction to practice or an actual reduction to practice. Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not merely enough to allege that the applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.C. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing reduction to practice (see M.P.E.P. Section 715.07(a)). There is no evidence provided to show diligence between the September 15, 1998 filing date of the O'Neill reference and the applicant's April 5, 1999 filing date.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined

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was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 3, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,219,653 to O'Neill et al..

5. As to claim 1, O'Neill teaches a method for establishing a trading relationship between trading partners involved in electronic commerce, the method comprising: retrieving configuration details associated with a potential trading partner from a remote site (col. 5, lines 66-67 and col. 6, lines 1-15); and automatically configuring a trading relationship with the potential trading partner using the configuration details (col. 8, lines 13-33).

6. As to claim 3, O'Neill teaches a method as recited in claim 1, wherein the automatically configuring comprises: creating a trading partner record (col. 12, lines 45-54); and automatically populating the trading partner record with the configuration details (col. 12, lines 45-54).

7. As to claim 8, claim 8 has the similar limitations as claims 1 and 3 combined and is thus rejected on the same basis as claims 1 and 3.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 2, 4-7, 9-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,219,653 to O'Neill et al..

10. As to claim 2, O'Neill teaches a method as recited in claim 1, wherein the retrieving comprises addressing a remote site to access the configuration details (col. 5, lines 66-67 and col. 6, lines 1-15); however, O'Neill does not explicitly teach the use of a URL to access the configuration details.

Official notice is taken that it is well known in the Information Technology art to use a URL for addressing a remote site.

It would have been obvious to one of ordinary skill in the Information Technology art at the time of the invention to combine the teachings of O'Neill regarding a method for retrieving configuration details and establishing a trading relationship with a URL for addressing configuration details because O'Neill discloses that his invention could operate using a global communications network (col. 7, lines 63-67 and col. 8, lines 1-13) and a URL is a common way to access remote sites on a global communications network.

11. As to claim 4, O'Neill teaches a method in an electronic commerce trading system involving exchanges of commerce information over a network, a method comprising: collecting configuration details associated with a trading partner participating in the commerce trading system (col. 16, lines 22-52); and publishing the configuration details to a site (col. 16, lines 53-67 and col. 17, lines 1-10); however, O'Neill does not explicitly teach the use of a Web site to display the configuration details.

Official notice is taken that it is well known in the Information Technology art to use a Web site to display information.

It would have been obvious to one of ordinary skill in the Information Technology art at the time of the invention to combine the teachings of O'Neill regarding the collection and publishing of configuration details with a web site because O'Neill discloses that his invention could operate using a global communications network (col. 7, lines 63-67 and col. 8, lines 1-13) and a web site is a common way to display information on a global communications network.

12. As to claim 5, O'Neill teaches a method wherein the collecting of configuration details comprises the presentation of a graphical user interface to enable a user to enter the configuration details (Figures 5A-F).

13. As to claims 6, 9, 13, 14, 19, 20, 24, 25, 31, 37, and 38, claims 6, 9, 13, 14, 19, 20, 24, 25, 31, 37, and 38 are rendered obvious in light of O'Neill for the same reasons discussed in the rejection of claim 2.

14. As to claim 7, O'Neill teaches a method wherein the site is associated with the trading partner (col. 8, lines 34-51, Each seller posts its associated data to the platform site.).

For reasons discussed in the rejection of claim 4, it would have been obvious to combine the teachings of O'Neill regarding associating a trading partner with a web site.

15. As to claim 10, claim 10 has the similar limitations as claims 4 and 8 combined and is thus rejected on the same basis as claims 4 and 8.

16. As to claims 11, 17, 23, and 34, claims 11, 17, 23, and 34 are rendered obvious in light of O'Neill for the same reasons discussed in the rejection of claim 5.

17. As to claim 12, O'Neill teaches a method of publishing configuration details; however O'Neill does not teach the use of an XML format to publish the details.

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Official notice is taken that it is well known in the Information Technology art to publish information to a web site using an XML format.

It would have been obvious to one of ordinary skill in the Information Technology art at the time of the invention to combine the teachings of O'Neill regarding a trading system with an XML display format because XML provides more extensibility than other display formats.

18. As to claim 15, O'Neill teaches a system comprising: a first computer system at a first trading partner (col. 6, lines 37-48); a second computer system at a second trading partner (col. 6, lines 37-48); a site (col. 5, lines 54-65, trading platform); the first computer system collecting configuration details associated with the first trading partner and publish the configuration details to the site (col. 16, lines 22-67 and col. 17, lines 1-10); and the second computer system retrieving the configuration details from the site (col. 5, lines 66-67 and col. 6, lines 1-15) and automatically configure for a trading relationship with the first trading partner using the configuration details (col. 8, lines 13-33); however O'Neill does not explicitly teach a system using a web site.

For reasons discussed in the rejection of claim 4, it would have been obvious to combine the teachings of O'Neill regarding system for establishing a trading relationship and the use of a web site.

19. As to claim 16, O'Neill teaches a system wherein the first computer system hosts a web site (col. 16, lines 53-67 and col. 17, lines 1-10); however, O'Neill does explicitly teach that the web site has configuration details.

O'Neill teaches a system wherein the configuration details are published at a site (col. 16, lines 53-67 and col. 17, lines 1-10).

It would have been obvious to one of ordinary skill in the Information Technology art at the time of the invention to combine the teachings of O'Neill regarding a web site with the teachings of O'Neill regarding publishing configuration details because the details would be a logical thing for the seller to put on their web site.

20. As to claims 18 and 35, claims 18 and 35 are rendered obvious in light of O'Neill for the same reasons discussed in the rejection of claim 12.

21. As to claims 21 and 26, they have similar limitations to claim 3 and are thus rejected on the basis as claim 3.

22. As to claims 22 and 27, they have similar limitations to claim 15 and are thus rejected on the same basis as claim 15.

23. As to claims 28 and 29, the limitations for claims 28 and 29 are included in claim 27. Therefore, the same rejection applies.

24. As to claim 30, O'Neill teaches a method for establishing a trading relationship between trading partners involved in electronic commerce, the method comprising: retrieving configuration details associated with a first potential trading partner from a remote site by a second potential trading partner (col. 5, lines 66-67 and col. 6, lines 1-15); and automatically configuring a trading relationship with the first and the second potential trading partners using the configuration details (col. 8, lines 13-33); however, O'Neill does not explicitly teach retrieving configuration details associated with the second trading partner from a remote site by the first potential trading partner.



O'Neill does teaches that a client can be a broker, performing both buying and selling functions (col. 6, lines 15-36). In the case where two brokers are trading, both brokers could retrieve configuration details from each other.

It would have been obvious to one of ordinary skill in the Information Technology art at the time of the invention to combine the teachings of O'Neill regarding establishing a trading relationship with the idea of trading between two brokers because in O'Neill's embodiment a buyer or seller could be a broker.

25. As to claim 32, claim 32 has similar limitations to claim 3 and is thus rejected on the same basis as claim 3.

26. As to claim 33, O'Neill teaches a method for establishing a trading relationship between first and second trading partners involved in electronic commerce, the method comprising: collecting configuration details associated with the first trading partners (col. 16, lines 22-52); publishing the first configuration details to at least one site (col. 16, lines 53-67 and col. 17, lines 1-10); creating, at the second trading partner, a trading partner record for the first trading partner (col. 12, lines 45-54); retrieving the configuration details associated with the first trading partner from the site (col. 5, lines 66-67 and col. 6, lines 1-15); and populating the trading partner record of the second trading partner with the configuration details associated with the first trading partner (col. 12, lines 45-54); however O'Neill does not explicitly teach a system using a web site or a second partner also initiating a trade relationship.

For reasons discussed in the rejection of claim 4, it would have been obvious to combine the teachings of O'Neill regarding a method for establishing a trading relationship and the use of a web site.

For reasons discussed in the rejection of claim 30, it would have been obvious to combine the teachings of O'Neill regarding a method for establishing a trading relationship and the mutual trading by broker clients.

27. As to claim 36, O'Neill teaches a method wherein the publishing comprises publishing the first configuration details at a first site associated with the first trading partner and the second configuration details at a second site associated with the second trading partner (col. 8, lines 34-51, Each seller posts its associated data to the platform site.); however O'Neill does not explicitly teach a system using a web site.

For reasons discussed in the rejection of claim 4, it would have been obvious to combine the teachings of O'Neill regarding system for establishing a trading relationship and the use of a web site.

28. As to claim 39, claim 39 has the similar limitations as claims 30 and 33 combined and is thus rejected on the same basis as claims 30 and 33

### ***Conclusion***

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B Blair whose telephone number is 703-305-5267. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Powell can be reached on 703-305-9703. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.

Douglas Blair  
April 1, 2003

DBB

  
MARK R. POWELL  
SUPERVISORY PATENT EXAMINER  
GROUP 2400